



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 4

COPY MAILED

OCT 21 2002

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

In re Application of
Matthews, et al.
Application No. 10/067,106
Filed: February 4, 2002
Atty. Dkt. No.: 1384.004US3
Title: SYSTEM AND PROTOCOL FOR
FRAME RELAY SERVICE OVER THE
INTERNET

:
:
: DECISION REFUSING
: STATUS UNDER 37 CFR
: 1.47(a)
:
:
:

OFFICE OF PETITIONS

This decision is in response to the petition under 37 CFR 1.47(a), filed September 16, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed February 4, 2002 without an executed oath or declaration. Accordingly, a Notice to File Missing parts of Nonprovisional Application was mailed April 9, 2002 requiring, among other items, an executed oath or declaration and a surcharge. The instant petition naming Abraham R. Matthews, Sajit Bhaskaran, Lianghwa Jou, and Sachin Desai as joint inventors was filed in response.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

The instant petition lacks items (1) and (2) set forth above.

As to item (1), petitioner has failed to establish that the inventor received the application papers (specification, claims, drawings, and oath or declaration) and thereafter refused to execute the oath or declaration.

The affidavit of Rodney L. Lacy indicates that the non-signing inventor was sent a copy of the patent papers for application No. 09/663,486 and thereafter refused to execute the declaration application No. 09/663,486.

Application No. 10/067,106

Petitioner is reminded that before a refusal to sign an oath or declaration can be alleged, it must be demonstrated that a *bona fide* effort has been made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. Petitioner has presented no evidence that the non-signing inventor was ever presented with a copy of the application papers (specification, claims, drawings, oath or declaration) for the instant application. While the affidavit of Rodney L. Lacy references a written refusal to execute a declaration in a prior application, there is no indication that the inventor ever received the application papers for the instant application and thereafter refused to execute the declaration.

Any renewed petition should be accompanied by evidence to sufficiently establish that the non-signing inventor either cannot be located or that the non-signing inventor was sent a complete copy of the application papers and thereafter refused to execute the declaration. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the non-signing inventor's attorney. Petitioner may wish to provide the Office copies of letters sent to the inventor indicating the enclosure of the application papers (specification, claims, drawings, and oath or declaration). If after the inventor receives the application papers and requests to execute the oath or declaration are refused, these facts should be set forth in a statement of facts signed by the person to whom the refusals were made and detailing with specificity the exact manner of the refusals. If a written refusal has been made, a copy of the written refusal should be included on renewed petition.

However, petitioner is advised that if Rule 47 status has been accorded in a prior application in a previous decision on petition, petitioner may submit a copy of the decision upon renewed petition in accordance with 37 CFR 1.47(c).

As to item (2), the declaration is unacceptable as the citizenship the non-signing inventor is contrary to the citizenship claimed by the inventor in the copy of the E-mail referenced in and attached to the petition. Whereas the inventor claims to be of Singapore citizenship, the declaration indicates the inventor is of United States citizenship. Any renewed petition should include an oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn.: Office of Petitions

Application No. 10/067,106

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0310.



Alesia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy